

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/598,896
ATTORNEY DOCKET NO. Q59609

REMARKS

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority, and for indicating that the certified copy of the priority document, European Patent Application No. 99500108.8 dated June 25, 1999, has been made of record in the file.

The Examiner objects to the Abstract as containing reference numerals. Applicant herein amends the Abstract to remove the reference numerals. No new matter was added. Applicant requests that the Examiner withdraw the objection to the Abstract.

Claims 1-13 have been examined on their merits.

The Examiner objects to claims 1-13 due to the term "characterized." The Examiner further objects to claims 1-5 and 7-13 due to the reference numerals. Applicant herein amends claims 1-13 to remove the term "characterized" and the reference numerals, and the Examiner withdraw the objection to claims 1-13.

Applicant herein adds new claims 14-17. No new matter has been added. Entry and consideration of the new claims 14-17 is respectfully requested.

Claims 1-17 are all the claims presently pending in the application.

1. Claims 1, 2, 6-9 and 13 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Cheng (U.S. Patent No. 5,563,883). Applicant traverses the rejection of claims 1, 2, 6-9 and 13 at least for the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies*,

Inc., 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Cheng fails to teach or suggest a method that increases or/and decreases a predetermined number of virtual identities for signaling based on the level of occupancy of a signaling multiframe, as recited in claim 1. Instead, Cheng discloses, *inter alia*, that signaling data channels remain constant, *e.g.*, signaling data channels FD and RD. Each kind of channel is in two type of channels, *e.g.*, FD is shared in FD-1 and FD-2, the latter being a reserved signalling channel. When there is a collision in the FD-1 channel, the fixed station or base station sends the signaling by means of the FD-2 channel which is a backup signaling channel. *See* col. 6, lines 34-51 of Cheng. There is no disclosure in Cheng of increasing and/or decreasing a predetermined number of virtual identities based on an occupancy level of signaling multiframe.

Based on the foregoing reasons, Applicant submits that Cheng fails to disclose all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, Cheng clearly cannot anticipate the present invention as recited in independent claim 1. Thus,

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Applicant submits that claim 1 is allowable, and further submits that claims 2, 6 and 7 are allowable as well, at least by virtue of their dependency from claim 1. Applicants respectfully request that the Examiner withdraw the § 102(b) rejection of claims 1, 2, 6 and 7.

With respect to claim 8, Cheng fails to teach or suggest a system that comprises a first controller means that increases or/and decreases a predetermined number of virtual identities for signaling based on the level of occupancy of a signaling multiframe, as recited in claim 8. For the same reasons as discussed above with respect to claim 1, Applicant submits that there is no disclosure in Cheng of a means that increases and/or decreases a predetermined number of virtual identities based on an occupancy level of signaling multiframe.

Based on the foregoing reasons, Applicant submits that Cheng fails to disclose all of the claimed elements as arranged in claim 8. Therefore, under *Hybritech* and *Richardson*, Cheng clearly cannot anticipate the present invention as recited in independent claim 8. Thus, Applicant submits that claim 8 is allowable, and further submits that claims 9 and 13, as well as new claims 14-17, are allowable as well, at least by virtue of their dependency from claim 8. Applicants respectfully request that the Examiner withdraw the § 102(b) rejection of claims 8, 9 and 13.

2. Claims 3-5 and 10-12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cheng in view of Grauel *et al.* (U.S. Patent No. 4,573,206). Applicant traverses the rejection of claims 3-5 and 10-12 at least for the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on

the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

Claims 3-5 depend from claim 1, and therefore include all the recitations of claim 1 by virtue of their dependency.

The combination of Cheng and Grauel *et al.* fails to teach or suggest a method that increases or/and decreases a predetermined number of virtual identities for signaling based on the level of occupancy of a signaling multiframe, as recited in claim 1 and included via dependency in claims 3-5. As discussed above with respect to claim 1, Cheng lacks any disclosure with respect to varying the number of virtual identities for signaling based on occupancy. Grauel *et al.* discloses the reassignment of group codes to control the amount of traffic, but Grauel *et al.* does not teach or suggest varying the number of virtual identities for signaling based on occupancy levels. *See, e.g.*, col. 2, lines 35-50 of Grauel *et al.* Thus, Applicant submits that the Examiner cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Since neither Cheng nor Grauel *et al.* disclose increasing and/or decreasing a predetermined number of virtual identities due to occupancy levels, Applicant submits that one of ordinary skill in the art would not be motivated to combine the two references. *In re Dembiczak* and *In re Zurko* require the Examiner to provide particularized facts on the record as

to why one of skill would be motivated to combine the two references. Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Examiner must make specific factual findings with respect to the motivation to combine references. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002). Although the Examiner provides a motivation analysis with a predetermined number of signaling channels, both Cheng and Grauel *et al.* lack any teaching about the desirability of increasing and/or decreasing a predetermined number of virtual identities due to occupancy levels. Thus, Applicant submits that the Examiner cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicant submits that the combination of Cheng and Grauel *et al.* fails to disclose all of the claimed elements as arranged in claim 1, and included via dependency in claims 3-5. Therefore, the combination of Cheng and Grauel *et al.* clearly cannot render the present invention obvious as recited in claims 3-5, and Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of claims 3-5.

Claims 10-12 depend from claim 8, and therefore include all the recitations of claim 8 by virtue of their dependency.

The combination of Cheng and Grauel *et al.* fails to teach or suggest a device with a first controller means that increases or/and decreases a predetermined number of virtual identities for signaling based on the level of occupancy of a signaling multiframe, as recited in claim 8 and

included via dependency in claims 10-12. As discussed above with respect to claim 8, Cheng lacks any disclosure with respect to a device for varying the number of virtual identities for signaling based on occupancy. As discussed above with respect to claims 3-5, Grauel *et al.* discloses the reassignment of group codes to control the amount of traffic, but Grauel *et al.* does not teach or suggest varying the number of virtual identities for signaling based on occupancy levels. *See, e.g.*, col. 2, lines 35-50 of Grauel *et al.* Thus, Applicant submits that the Examiner cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Since neither Cheng nor Grauel *et al.* disclose a first controller means that increases and/or decreases a predetermined number of virtual identities due to occupancy levels, Applicant submits that one of ordinary skill in the art would not be motivated to combine the two references. Although the Examiner provides a motivation analysis with a predetermined number of signaling channels, both Cheng and Grauel *et al.* lack any teaching about the desirability of increasing and/or decreasing a predetermined number of virtual identities due to occupancy levels. Thus, Applicant submits that the Examiner cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicant submits that the combination of Cheng and Grauel *et al.* fails to disclose all of the claimed elements as arranged in claim 8, and included via dependency in claims 10-12. Therefore, the combination of Cheng and Grauel *et al.* clearly cannot render the present invention obvious as recited in claims 10-12, as well as in new claims

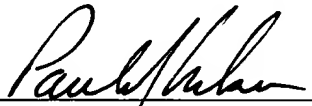
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14-17, and Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of claims 10-12.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

Date: January 27, 2004

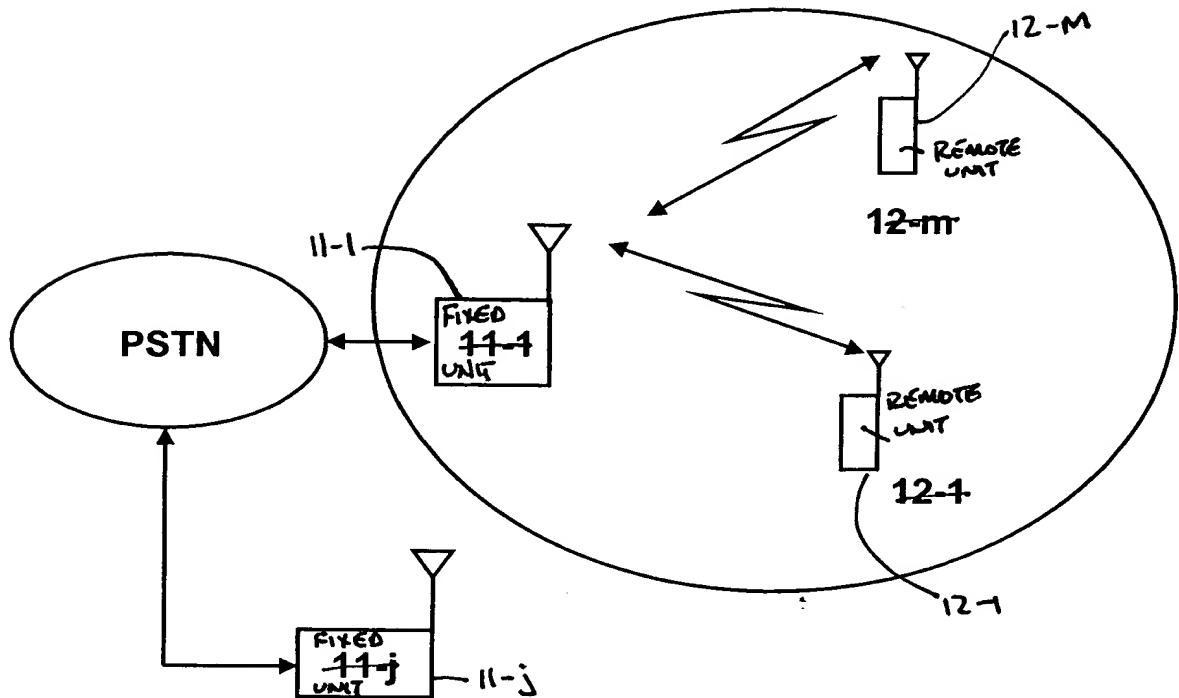


FIG. 1

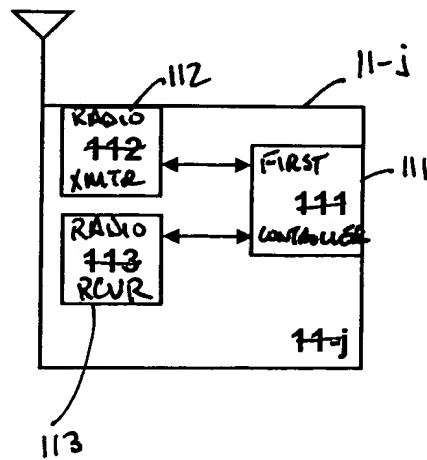


FIG. 2

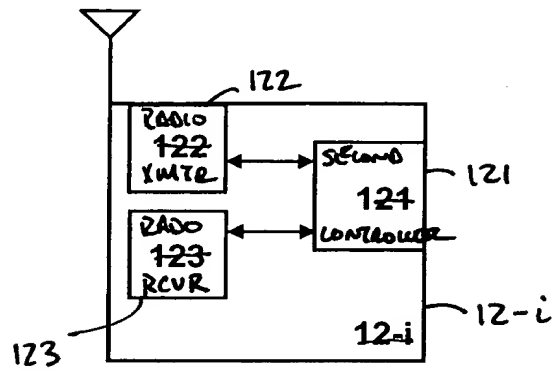


FIG. 3